

Appl. No. 10/078,043  
Atty. Docket No. 8431M  
Reply Dated November 12, 2003  
Reply to Office Action of August 12, 2003  
Customer No. 27752

REMARKS/ARGUMENTS

Claims 1, 3-10, 13 and 14 have been amended. No Claims have been canceled, no claims have been withdrawn and Claims 1-20 remain pending in the present application. No claims and no new matter have been added, and no additional claim fee due. Entry of this Amendment is respectively requested.

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### REJECTIONS

#### Rejections Under 35 U.S.C. §112

##### 35 U.S.C. §112 Second Paragraph

###### 1) Claim 7, 8, 13 and 14

Claims 7, 8, 13 and 14 have been rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action noted that these claims fail to provide any structural limitations which are supportive of the recited functions. Applicants respectively traverse the rejection.

Applicants have amended Claims 7, 8, 13 and 14 to remove the recited functions from the claims. The claims are now directed to structural limitations.

Consequently, in view of the foregoing remarks, it is respectfully requested that the rejection of Claim 7, 8, 13 and 14 be reconsidered and withdrawn.

#### Rejections Under 35 U.S.C. §102

##### Eckhouse

Claims 1-20 have been rejected under 35 U.S.C. §102(b) as being anticipated by Eckhouse US Patent No 5,720,772. It is the Examiner's contention that that the claimed articles are anticipated by the disclosure of Eckhouse. Applicants respectively traverse the rejection.

Section 2131 of the MPEP states to anticipate a claim, the reference "MUST TEACH EVERY ELEMENT OF THE CLAIM" (emphasis in original). Applicants respectfully submit that all the claim limitations are not taught or suggested by Eckhouse, as shown below.

Applicants submit that Eckhouse does not teach every element of Applicants' amended Claim 1. Applicants' claimed invention requires that the "apparatus is adapted for placement proximate to the *in-vivo* location of said pathogen wherein said *in-vivo* location of said pathogen is a plant or parts thereof". (Emphasis added). This element is missing from Eckhouse, which is only directed to an

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apparatus for treatment of skin, or blood vessels accessed by invasive surgery, i.e. animals. See Eckhouse abstract, Columns 3, line 50 to column 4, line 17, and Claims 1-3. Eckhouse is concerned about treatment of blood either indirectly through the skin, or directly by treating blockages in the interior of blood vessels accessed by invasive surgery, or other problems associated with vascular malformation. Applicants Claim 1, as amended, comprises an apparatus adapted for the treatment of *in-vivo* pathogens present in and/or plants or parts thereof. Eckhouse does not teach each and every claim element. Consequently, Claim 1 and the claim dependent therefrom, i.e. Claim 2, are not anticipated by Eckhouse.

Furthermore, Claim 11 requires that the apparatus be "adapted for placement proximate" to the "tympanic membrane" of an animal. Eckhouse, makes no mention of the "tympanic membrane", let alone an apparatus which is adapted for placement proximate thereto. Eckhouse does not teach each and every claim element. Consequently, Claim 11 and the claims dependent therefrom, i.e. Claims 3-10 and 12-15, are not anticipated by Eckhouse.

Lastly, the Office Action asserts that Claims 10 and 15-20 are anticipated by Eckhouse, since "the light energy of Eckhouse is directed towards skin tissue which would inherently include pathogens". The Office Action has missed the point, as Eckhouse fails to disclose all the elements of the claims. For Example, Claim 10, now amended to be dependent upon Claim 11, is a method of using a device which is adapted for adapted for placement proximate" to the "tympanic membrane" of an animal. There is no disclosure of this element in Eckhouse. Furthermore, Claims 15 -20 require that the electromagnetic radiation be administered to achieve meaningful suppression of an *in-vivo* pathogen. Eckhouse makes no mention of pathogens, let alone how one would achieve a meaningful suppression of any pathogens. Consequently, Claims 10, 15 and the claims dependent therefrom, i.e. Claims 16-20 are not anticipated by Eckhouse.

In view of the foregoing remarks and the clarifying amendments, it is respectfully requested that rejection of Claim 1-20 be reconsidered and withdrawn.

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Rejection under 35 U.S.C. 103

1) Eckhouse in view of Talmore

Claims 10 and 15-20 are rejected under 35 U.S.C. §103 as being obvious over Eckhouse, US Patent No 5,720,772 in view of Talmore, US Patent No. 5,344,433. It is asserted in the Office Action that the claimed device is obvious in light of what is taught by Eckhouse in view of Talmore. Applicants respectfully traverse the rejection.

It is well known that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Roussel 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP 706.02(j); In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP Section 2143 - Section 2143.03.

Turning to the present rejection, it is clear that the Office Action has failed to establish a prima facie case of obviousness. For a start, one of ordinary skill would have no motivation to combine Eckhouse with Talmore.

Firstly, Talmore is directed to an apparatus which only directs UV-A radiation on its target, and "eliminates from the beam all the radiation above 370 nm", (i.e. the visible portion and the IR portion of the electromagnetic spectrum.) See Column 3, lines 34-35. Talmore describes this elimination as "necessary". Column 3, line 45. In other words, Talmore teaches one of ordinary skill an apparatus which only provides a narrow wavelength of electromagnetic radiation,

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specifically UV-A radiation, and that all other wavelengths of electromagnetic radiation need to be eliminated. Eckhouse on the other hand is directed to a device for providing a broad spectra of electromagnetic radiation, e.g., Figure 18 has a spectrum of from approximately 544 nm to about 960 nm, and Column 5, line 25 teaches a spectrum of 300 nm to 1000nm, etc. This means that for one of ordinary skill to combine the teaching of Talmore with that of Eckhouse, they have to ignore the express teaching in Talmore to "eliminate.... all the radiation above 370 nm". One of ordinary skill would not do this. Instead one of ordinary skill in the art would not consider the combination of Talmore with that of Eckhouse in view of this express teaching away in Talmore.

Furthermore, there is nothing in Talmore that suggest the desirability of using "radiation above 370 nm". In reality Talmore is teaching away from this, i.e. all radiation above 370 nm must be eliminated. Here is not only no motivation in either Talmore or Eckhouse to combine the two, there is nothing that would give one of ordinary skill any expectation of success.

Furthermore, it is apparent that the rejection is applying the "obvious to try" standard which has been consistently held improper. It is well settled that the question of obviousness under 35 U.S.C. §103 is not what the artisan could have done, but rather what would have been obvious for such a person to do. See Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986), and In re Brouwer, 37 U.S.P.Q.2d 1663 (Fed. Cir. 1996). See also MPEP 2143.01; In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is unclear as to why one of ordinary skill would consider the combination of Talmore and Eckhouse relevant. Furthermore, there is no teaching, motivation and/or suggestion to one of ordinary skill modify any possible combination of Talmore and Eckhouse and the only suggestion provided in the Office Action has been impermissible hindsight based on Applicants' own teaching.

Consequently, in view of the foregoing remarks and the clarifying amendments, it is respectfully requested that the rejection of Claims 10, and 16-20 be reconsidered and withdrawn.

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CONCLUSION

In light of the amendments and remarks presented herein, Applicants respectively submit that Claims 1-20 are allowable over the prior art of record or any combination thereof. In the event that issue remain prior to allowance of the noted claims, then the Examiner is invited to call Applicants' undersigned agent to discuss any remaining issues.

Respectfully submitted,

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